

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400



PATENT APPLICATION

ATTORNEY DOCKET NO. 300203672-2

IN THE

UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): John Deryk WATERS

Confirmation No.: 8521

Application No.: 10/697,319

Examiner: Pawandeep DHINGRA

Filing Date: 10/31/2003

Group Art Unit: 2625

Title: APPARATUS FOR PRINTING, DATA WRITING TO MEMORY TAGS AND DATA READING FROM MEMORY TAGS, AND METHODS THEREFOR

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on June 10, 2008.

- The fee for filing this Appeal Brief is \$510.00 (37 CFR 41.20).
 No Additional Fee Required.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

- (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

1st Month \$120 2nd Month \$460 3rd Month \$1050 4th Month \$1640

- The extension fee has already been filed in this application.

- (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 510. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Respectfully submitted,

John Deryk WATERS

By W. Keith Robinson

W. Keith Robinson

Attorney/Agent for Applicant(s)

Reg No. : 59,396

Date : June 10, 2008

Telephone : 202-672-5300

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John Deryk WATERS

By J. Deryk WATERS

W. Keith Robinson

Attorney/Agent for Applicant(s)

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Atty. Dkt. No. 300203672-2

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: John Deryk WATERS

Title: APPARATUS FOR PRINTING,
DATA WRITING TO MEMORY
TAGS AND DATA READING
FROM MEMORY TAGS, AND
METHODS THEREFOR

Appl. No.: 10/697,319

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Art Unit: 2625

Confirmation 8521

Number:

BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Under the provisions of 37 C.F.R. § 41.37, this Appeal Brief is being filed together with a credit card payment form in the amount of \$510.00 covering the 37 C.F.R. 41.20(b)(2) appeal fee. If this fee is deemed to be insufficient, authorization is hereby given to charge any deficiency (or credit any balance) to the undersigned deposit account 08-2025.

06/11/2008 AWONDAF1 00000040 082025 10697319
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REAL PARTY IN INTEREST

The real party in interest is Hewlett Packard Development Company, L.P. in Houston Texas, U.S.A.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences that will directly affect, be directly affected by or have a bearing on the present appeal, that are known to appellant, the assignee, or the appellant's patent representative. The Related Proceedings Appendix, attached hereto, states "None".

STATUS OF CLAIMS

Claim 5 was withdrawn from consideration. Claims 1-4 and 6-13 are pending on appeal. A copy of the pending claims is presented in the CLAIMS APPENDIX. These claims have been finally rejected. Rejections of claims 1-4 and 6-13 are appealed.

STATUS OF AMENDMENTS

In response to a Restriction Requirement, Claims 1-4 and 6-13 were elected for examination on August 13, 2007. No amendments are being filed with this Appeal Brief or are outstanding.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 recites an apparatus 10 for data printing and data writing to a memory tag 8 on or in a base medium, the apparatus having a print head 16 for printing onto the base medium 12, and a memory tag write device 20 for data writing to the memory tag 8 on or in the base medium 12, wherein the base medium 12 is moved along a first axis A1 through or past the apparatus 10, and at least a part of the memory tag write device 20 required for communication with the memory tag 8 is moveable relative to the base medium 12 back and

forth along a second axis A2 substantially perpendicular to the first axis A1. (page 3, line 22 to page 4, line 2)

Independent claim 11 recites an apparatus 10 for data printing onto a base medium 12 and data writing to a memory tag 8 on or in the base medium 8, the apparatus 10 having a print head 16 for printing onto the base medium 12, and a memory tag write device 20 for data writing to the memory tag 8, wherein the base medium 12 is moved along a first axis A1 through or past the apparatus 10, the print head 16 is moveable relative to the base medium 12 and moves back and forth along a third axis A3 substantially perpendicular to the first axis A1, and at least a part of the memory tag write device 20 which is required for communication with the memory tag 8 is moveable relative to the base medium 12 back and forth along a second axis A2 substantially perpendicular to the first axis A1. (page 3, line 22 to page 4, line 12)

Independent claim 12 recites a method of printing onto a base medium 12 and writing to a memory tag 8 on or in the base medium 12 comprising the steps of:

- i) feeding (page 4, line 28; page 3, lines 19-21) the base medium 12 along a first axis A1 past a print head 16;
- ii) printing (page 4, line 29) onto the base medium 12;
- iii) feeding (page 4, line 28 to page 5, line 5) the base medium 12 past a memory tag write device 20;
- iv) moving (page 4, lines 5-12) the memory tag write device 20 along a second axis A2 substantially perpendicular to the first axis A1 to the location of a memory tag 8 in or on the base medium 12, and
- v) writing (page 5, lines 1-5) data to the memory tag 8 in or on the base medium 12.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are:

(1): whether the examiner erred in rejecting claims 1, 2, 6-8 and 11-13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,645,327 to Austin et al. (hereinafter “Austin”), and

(2): whether the examiner erred in rejecting claims 3, 4, 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Austin as in view of U.S. Patent 6,857,714 to Hohberger et al. (hereinafter “Hohberger”).

ARGUMENT

I. It is respectfully submitted that the final rejection of claims 1, 2 and 6-11 under 35 U.S.C. § 102(b) is erroneous for at least the following reason.

i. Independent claims 1 and 11:

Independent claim 1 recites (with emphasis added):

An apparatus 10 for data printing and data writing to a memory tag 8 on or in a base medium, the apparatus having a print head 16 for printing onto the base medium 12, and a memory tag write device 20 for data writing to the memory tag 8 on or in the base medium 12, **wherein the base medium 12 is moved along a first axis A1 through or past the apparatus 10, and at least a part of the memory tag write device 20 required for communication with the memory tag 8 is moveable relative to the base medium 12 back and forth along a second axis A2 substantially perpendicular to the first axis A1.**

Thus, the invention as claimed enables the writing of data onto a base medium and a memory tag at the same time. This enables much more rapid production of documents having both visible and electronically stored data. See, for example, the description on pages 3 through 5 of the specification and Figures 1 through 3 of the drawings.

Austin is directed towards an RF tag application system. Austin teaches forming printing labels with electronic tags applied thereon. Label stock is fed to a printer that prints on the label stock. Tags are applied to the back face of the label, and then cut into discrete labels that are utilized for labeling and identifying various packages or luggage. (column 2, lines 33-52)

Austin fails to teach or disclose the features of the invention as claimed, specifically failing to teach an apparatus “wherein the base medium 12 is moved along a first axis A1 through or past the apparatus 10” and “at least a part of the memory tag write device 20 which is required for communication with the memory tag 8 is moveable relative to the base medium 12 back and forth along a second axis A2 substantially perpendicular to the first axis A1.” (Independent claim 1)

With regards to the feature of an apparatus “wherein the base medium 12 is moved along a first axis A1 through or past the apparatus 10,” there is no disclosure in Austin of the base medium moved along a first axis through or past the apparatus. In Austin, the base medium would be the label media 100. However, careful reading of the disclosure of Austin, and the corresponding drawings, show that the media 100 does not move along a single axis. Rather, as shown in Figure 2, and the following passage, the media does not move in a linear fashion along an axis through or past the apparatus:

“Referring to FIGS. 1 and 2 , the printer 2 has a housing 4 in which the working elements of the printer 2 are mounted. These working elements are illustrated in schematic form in FIG. 2 . They include a media supply roller 6 for mounting rolls of label media 100 . As shown, the label media 100 includes a strip of label stock 102 having an adhesive coated back face protected by a liner 108. However, the apparatus of the invention preferably is configured to receive a linerless label media. Still referring to FIG. 2 , **media 100 from the supply roller 6 is drawn from the supply roller 6 and extends along a media guide pathway around a guide roller 8 past a label gap sensor 10 to a print station having a printhead 12 for printing on a front face 104 of the label stock 102.**”

(column 5, lines 47-60; emphasis added)

Figure 2 shows that, as the media is drawn from the supply roller 6 around the guide roller 8, the axis of alignment of the media 100 changes. Thus, there is no axis A1 on which the base medium is moved through or past the apparatus. The axis of movement used for printing onto the media 100 is different from the axis utilized for applying the RF tag to the media. Further, Austin teaches yet another axis for removing the liner form the media 100. It is unclear in the Office Action which axis would be interpreted to be the first axis A1 on

which the base medium is moved along through the apparatus. The Examiner asserts in the Office Action that axis A1 is the “right to left axis, see Fig. 2.” However, analysis of Figure 2 fails to show a single right to left axis. Rather, as we have detailed herein, there are at least three axes utilized in moving the media 100 through the apparatus. Thus, Applicants respectfully submit that Austin fails to teach or disclose an apparatus “wherein the base medium 12 is moved along a first axis A1 through or past the apparatus 10.”

Further, Austin fails to teach or disclose that “at least a part of the memory tag write device 20 required for communication with the memory tag 8 is moveable relative to the base medium 12 back and forth along a second axis A2 substantially perpendicular to the first axis A1.” As noted above, there is no single axis A1 in Austin on which the base medium is moved. The Examiner asserts that the second axis A2 to be “into and out of the page when looking at Figure 2.” (Office Action, page 4, item 2, paragraph 2, lines 10-11). However, a careful reading of the passages cited by the Examiner does not provide any support for the assertion that any element in Figure 2 moves in and out of the page.

Further, the Examiner asserts that RF write head 44 of Austin anticipates a memory tag write device. (Office Action, page 4, item 2, paragraph 2, line 4). The Examiner then interprets supply roller 34 to be part of the memory tag write device. There is no teaching or disclosure in Austin that the supply roller 34 is part of the memory tag write device. Rather, as evidenced by the following passage, Austin teaches that a strip of RF tags is drawn from a supply roller and moved along a tag guide pathway. The pathway extends to a tag gap sensor, and then to an RF write head:

“Referring to FIG. 2, the strip 110 is drawn from the roller 34 and extends along a tag guide pathway that includes a curved guide plate 36 and guide rollers 38 , 40 for guiding the strip 110. The guide rollers 38, 40 oppose each other in a known manner. The strip 110 extends from the rollers 38, 40 past a tag gap sensor 42 that verifies the location of the beginning of a tag and measures the length of the tag, in much the same manner that the label gap sensor 10 operates, to index the tag with the label to which it is to be applied. Past the sensor 42 is an RF write head 44 that electronically writes desired RF information onto a particular tag. This arrangement contemplates the tags being supplied in a

nonfunctional form so that the tags can be customized at the point of use. In addition to indexing the tag location to the corresponding label, the sensor 42 ensures that the RF write head 44 is properly aligned with the tag.” (column 6, lines 50-65; emphasis added).

Austin further teaches that the RF write head is positioned between the tag supply station and the tag application station. (column 3, lines 23-25). There is no teaching or suggestion in Austin that the supply roller 34 would be part of the RF write head. Rather, Austin teaches that the supply roller is part of the tag supply station (column 6, lines 28-32). Thus, the RF write head and the supply roller 34 are clearly two separate entities. Applicants respectfully submit that the supply roller 34 is NOT a part of the RF write head 44.

Further, even if the supply roller were incorrectly interpreted to be a part of the RF write head, there is still no teaching or disclosure in Austin that the supply roller was moveable relative to the media 100 back and forth along a second axis A2 substantially perpendicular to the first axis A1. There is no teaching or suggestion in Austin that the supply roller is moveable, let alone that the supply roller moves in an axis in and out of the page as asserted by the Examiner. (*Ibid*).

Further, Applicants respectfully submit that the RF write head 44 is also not moveable relative to the media 11 back and forth along a second axis A2 substantially perpendicular to the first axis A1. There is no disclosure or teaching in Austin of such a feature. Further, in the Response to Arguments, the Examiner clearly asserted that “examiner never stated that element 44 moves back and forth on an axis perpendicular to the base medium.” (Office Action, page 3, lines 7-8) Rather, the Examiner clearly stated that the supply roller was utilized to teach an element that moves back and forth on an axis perpendicular to the base medium. However, as shown above, the supply roller is not part of the RF write head, nor does it move in the manner required by the invention as claimed. Applicants respectfully submit that Austin fails to teach or disclose an apparatus with a memory tag write device, wherein “at least a part of the memory tag write device 20 required for communication with the memory tag 8 is moveable relative to the base medium 12 back and forth along a second axis A2 substantially perpendicular to the first axis A1.” There is no part of the memory tag write device of Austin that is moveable relative the media 100, let alone moveable along a second axis substantially perpendicular to the first axis.

As such, since there is no teaching or suggestion in Austin of an apparatus 10 for data printing and data writing to a memory tag 8 on or in a base medium, the apparatus having a print head 16 for printing onto the base medium 12, and a memory tag write device 20 for data writing to the memory tag 8 on or in the base medium 12, **wherein the base medium 12 is moved along a first axis A1 through or past the apparatus 10, and at least a part of the memory tag write device 20 required for communication with the memory tag 8 is moveable relative to the base medium 12 back and forth along a second axis A2 substantially perpendicular to the first axis A1.**, it cannot anticipate independent claims 1, 11 and 12 (whereby independent claims 11 and 12 recite similar features to those discussed above with respect to claim 1).

II. It is respectfully submitted that the final rejection of claims 3, 4, 9 and 10 under 35 U.S.C. § 103(a) is erroneous for at least the following reason.

Hohberger in no way makes up for the deficiencies of Austin as described above.

i. Independent claims 1 and 8:

Independent claim 1 recites (with emphasis added):

An apparatus 10 for data printing and data writing to a memory tag 8 on or in a base medium, the apparatus having a print head 16 for printing onto the base medium 12, and a memory tag write device 20 for data writing to the memory tag 8 on or in the base medium 12, **wherein the base medium 12 is moved along a first axis A1 through or past the apparatus 10, and at least a part of the memory tag write device 20 required for communication with the memory tag 8 is moveable relative to the base medium 12 back and forth along a second axis A2 substantially perpendicular to the first axis A1.**

There is no teaching or disclosure in Hohberger of an apparatus wherein the base medium is moved along a first axis through or past the apparatus and at least a part of a memory tag write device is moveable relative to the base medium back and forth along a second axis substantially perpendicular to the first axis. Rather, Hohberger is directed towards a thermal transfer media printer that is configured to be capable of including value-added elements (Abstract). For example, Hohberger teaches that the thermal transfer printer

can allow a programmed RFID transponder to be fixed to a media sample. (page 5, lines 21-29) Applicants respectfully submit that Hohberger fails to teach a memory tag write device, let alone such a device that is moveable in the manner required by the invention as claimed.

The Examiner interprets elements 320 and 330 to be the memory tag write device, noting that “these supply mechanisms are part of the memory write device (i.e. print head)” (Office Action, page 8, paragraph 2, lines 2-3). However, element 320 corresponds to an inlay supply mechanism and a linear actuator. There is no teaching or disclosure in Hohberger that these mechanisms are utilized to write information on an RF tag, or that they are part of a memory tag write device. An inlay supply mechanism and linear actuator are in no way equivalent to a memory tag write device of the invention as claimed.

Further, the Examiner also interprets the print head 18 to be the memory tag write device, as shown above (*Ibid*). However, the print head 18 cannot both be interpreted to be the print head for the apparatus and the memory tag write device. Further, even if such an interpretation were not incorrect, there is no teaching or disclosure in Hohberger that the print head writes data on an RF tag.

Hohberger does teach an RFID transponder programmer as shown in the following passage:

“Referring to FIG. 5, a sectional, schematic view of the thermal transfer printer **48** shown in FIG. 3 is illustrated, wherein dispensing mechanism **66** is disposed in a fully retracted initial position. In the embodiment of the invention shown in FIG. 5, printer **48** includes utilizes an RF signal **108** that is emitted by transponder programmer antenna **110** to program the memory in RFID integrated circuit **44**. In the fully retracted position shown in FIG. 5, the now-programmed RFID transponder **52** is positioned directly under the transponder programmer antenna **110** .” (column 6, line 66 to column 7, line 8)

However, Applicants respectfully submit that a transponder programmer is in no way equivalent to a memory tag write device. Further, even if the transponder programmer were incorrectly interpreted to be the memory tag write device, there is no teaching or disclosure in

Hohberger that the transponder programmer is moveable in the manner required by the invention as claimed.

Thus, Applicants respectfully submit that Hohberger fails to teach a memory tag write device, and further fails to teach or disclose that “at least a part of the memory tag write device 20 required for communication with the memory tag 8 is moveable relative to the base medium 12 back and forth along a second axis A2 substantially perpendicular to the first axis A1.”

Further, the outstanding Office Action asserts that “it would have been obvious to one of ordinary skill in the art at the time the invention to modify the RF tag application system as disclosed by Austin to include the apparatus for applying RFID labels as taught by Hohberger for the benefit of ‘selectively incorporating a value-adding element such as, for example, a radio frequency identification (hereinafter called RFID) transponder with individual media samples on a programmed on-demand basis’.” (Office Action, page 8, paragraph 3). However, Applicants respectfully submit that Austin already discloses adding RFID tags to individual media samples (labels). Thus, the motivation to modify the teachings of Austin with the teachings of Hohberger is lacking. Further, it is respectfully submitted that the combination of the teachings of Hohberger with those of Austin would not be obvious to one skilled in the art. However, even if such a combination were incorrectly made, the combined teaching of Austin and Hohberger still fail to teach all of the features of pending claims 1-13.

CONCLUSION:

In view of the above, Appellants respectfully solicit the Honorable Board of Patent Appeals and Interferences to reverse the rejections of the pending claims and pass this application on to allowance.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 C.F.R. § 1.25. Additionally, charge any fees to Deposit Account 08-2025 under 37 C.F.R. § 1.16 through § 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Respectfully submitted,

Date 6/10/08

HEWLETT-PACKARD COMPANY
Customer Number: 22879
Telephone: (202) 672-5485
Facsimile: (202) 672-5399

By 

William T. Ellis
Registration No. 26,874

W. Keith Robinson
Registration No. 59,396

CLAIMS APPENDIX

1. (Original) Apparatus for data printing and data writing to a memory tag on or in a base medium, the apparatus having a print head for printing onto the base medium, and a memory tag write device for data writing to the memory tag on or in the base medium, wherein the base medium is moved along a first axis through or past the apparatus, and at least a part of the memory tag write device required for communication with the memory tag is moveable relative to the base medium back and forth along a second axis substantially perpendicular to the first axis.
2. (Original) Apparatus according to claim 1 wherein the print head is moveable relative to the base medium and moves back and forth along a third axis substantially perpendicular to the first axis.
3. (Original) Apparatus according to claim 2 wherein the print head and the part of the memory tag write device are connected together and move in unison along the second and third axes.
4. (Original) Apparatus according to claim 3 wherein the print head and the part of the memory tag write device are amalgamated into a single unit and the second and third axes coincide.

5. (Withdrawn) Apparatus according to claim 2 wherein the print head and the part of the memory tag write device move independently along the second and third axes.

6. (Original) Apparatus according to claim 1 wherein the memory tag write device is a memory tag read/write device, such that the data written to the memory tags can be read and checked after being written.

7. (Original) Apparatus according to claim 1 wherein the memory tag write device is a memory tag read/write device, such that data written to memory tags on previously printed base medium can be read from those memory tags when the previously printed base medium is moved through or past the apparatus.

8. (Original) Apparatus according to claim 7 wherein the data once read is used to print additional copies of the previously printed base medium.

9. (Original) Apparatus according to claim 1 wherein it is adapted to handle base medium in loose sheet form which passes through the apparatus.

10. (Original) Apparatus according to claim 9 wherein it is adapted to handle loose sheets of paper or like material.

11. (Original) Apparatus for data printing onto a base medium and data writing to a memory tag on or in the base medium, the apparatus having a print head for printing onto the base medium, and a memory tag write device for data writing to the memory tag, wherein the base medium is moved along a first axis through or past the apparatus, the print head is moveable relative to the base medium and moves back and forth along a third axis substantially perpendicular to the first axis, and at least a part of the memory tag write device which is required for communication with the memory tag is moveable relative to the base medium back and forth along a second axis substantially perpendicular to the first axis.

12. (Original) A method of printing onto a base medium and writing to a memory tag on or in the base medium comprising the steps of:

- i) feeding the base medium along a first axis past a print head;
- ii) printing onto the base medium;
- iii) feeding the base medium past a memory tag write device;
- iv) moving the memory tag write device along a second axis substantially perpendicular to the first axis to the location of a memory tag in or on the base medium, and
- v) writing data to the memory tag in or on the base medium.

13. (Original) A method according to claim 12 wherein it further includes the step of moving the print head relative to the base medium along a third axis substantially perpendicular to the first axis in order to print onto the base medium in required locations.

EVIDENCE APPENDIX

[None]

RELATED PROCEEDINGS APPENDIX

[None]